

§Appl. No. 09/867,753  
Amdt. dated February 26, 2004  
Reply to Office Action of, September 26, 2004

## **REMARKS**

### **Priority**

Applicants submit herewith a certified English translation of German Application No. 10027170.7, filed on May 31, 2000.

### **Information Disclosure Statement**

Applicants submit herewith an Information Disclosure Statement.

### **Rejection under §112, second paragraph**

Claims 1 and 14 have been replaced by claims 18-24. The term "PEM" is used throughout the specification to refer to polynucleotides and polypeptides having the disclosed properties; it does not appear to have been described in the specification as an acronym or abbreviation. Support for the new claims can be found throughout the specification, e.g., Page 4, lines 7-20. Fragments specific for human PEM (e.g., claims 21 and 22) are described in the specification, e.g., Page 3, lines 19-22; Page 13.

### **Rejection under §101**

The new claims recite that the recited polynucleotides are "isolated." The cell claims have been replaced with new claims that describe the cells as "transformed" and comprising an "exogenous copy of a polynucleotide" of claims 18 or 22. Support for this amendment can be found throughout the specification, e.g., Page 10, line 2-12.

### **Rejections under §102**

Claim 1 is rejected under §102(e) as allegedly anticipated by Rosen et al., US2002/0132753.

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The priority date of the present application is May 31, 2000. This date is prior to the Jan. 17, 2001 filing date of Rosen et al. A verified translation of the priority document (100 27 270.7) is attached to establish that the claimed invention was described in it.

The Examiner has not shown that the sequence of Rosen et al. is entitled to a filing date that is earlier than applicants' priority date of May 31, 2000 (i.e., the examiner has not established that the sequence of Rosen is recited in provisional applications 60/179,065 or 60/180,628 filed January 31, 2000 and February 4, 2000, respectively). Consequently, the examiner has not met the burden of establishing that the sequence disclosed in Rosen et al. anticipates claim 1.

Applicants do not have access to provisional applications filed at the PTO nor the ability to search sequences disclosed in them. On the other hand, provisional applications are available to the Examiner. Consequently, it is the Examiner's burden to prove that SEQ ID NO:368 of Rosen et al. has a priority date that antedates applicant's.

Claim 14 is rejected under §102(e) as allegedly anticipated by Reid et al.

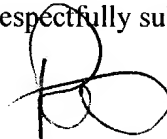
Reid et al. describe hPEM-2 which is a guanine nucleotide exchange factor, not a transcription factor comprising a homeobox domain. See, Specification, Page 2, lines 7-8. The sequence of Reid's protein was deposited in GenBank as AB007884, and is also known as KIAA0424 (Exhibit 1). See, Reid et al., legend to Fig. 1. A comparison of the sequence of KIAA0424 with human PEM shows that two sequences are not the same. Consequently, the sequences disclosed in Reid et al. do not anticipate the claimed invention.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

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The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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